

### **DETAILED ACTION**

Amendment after non-final office action filed on December 20, 2010 is acknowledged.

New claims 35-36 have been added. Claims 1-36 are pending in this application.

1. The Affidavit under 37 CFR 1.132 filed December 20, 2010 is sufficient to overcome the rejection of claims 1, 3-7 and 9 under 35 U.S.C. 102(e) as being anticipated by Rosen et al (US 2004/0137621) based upon Applicant's declaration that the inventions disclosed in US Patent Application 10/342,506 (US 2004/0137621) was derived from the inventor (Michael R. Rosen), and therefore, is not an invention by "another".

2. The Affidavit under 37 CFR 1.132 filed December 20, 2010 is sufficient to overcome the rejection of claims 1, 3-7 and 9 under 35 U.S.C. 103(a) as being unpatentable over Rosen et al (US 2004/0137621) and Donahue et al (US 2002/0155101) based upon Applicant's declaration that the inventions disclosed in US Patent Application 10/342,506 (US 2004/0137621) was derived from the inventor (Michael R. Rosen), and therefore, is not an invention by "another".

### ***Withdrawn Rejections***

3. Rejection of claims 6-7, 9 and 12 under 35 U.S.C. 112, second paragraph, is hereby withdrawn in view of Applicant's amendment to the claims.

4. Rejection of claims 1, 3-7 and 9 rejected under 35 U.S.C. 102(e) as being anticipated by Taheri et al (US Patent No. 6,690,970) is hereby withdrawn in view of Applicant's amendment to the claims.

5. Rejection of claims 1, 3-7 and 9 under 35 U.S.C. 102(e) as being anticipated by Rosen et al (US 2004/0137621) is hereby withdrawn in view of Applicant's Affidavit under 37 CFR 1.132 filed on December 20, 2010.

6. Rejection of claims 1, 3-7, 9 and 12 under 35 U.S.C. 103(a) as being unpatentable over Taheri et al (US Patent No. 6,690,970) in view of Donahue et al (US 2002/0155101) is hereby withdrawn in view of Applicant's amendment to the claims.

7. Rejection of claims 1, 3-7, 9 and 12 under 35 U.S.C. 103(a) as being unpatentable over Rosen et al (US 2004/0137621) in view of Donahue et al (US 2002/0155101) is hereby withdrawn in view of Applicant's Affidavit under 37 CFR 1.132 filed on December 20, 2010.

#### **EXAMINER'S AMENDMENT**

8. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ms. Judith Evans on February 15, 2011.

The application has been amended as follows:

**Claims 13-34, drawn to nonelected inventions are cancelled.**

**Claims 8 and 10-11, drawn to nonelected species are rejoined.**

**Claims 1-12 and 35-36 are allowed.**

**Claim 35 has been amended as follows:**

35. The method of claim 6, wherein the nucleic acid encodes an  
hyperpolarization-activated cyclic nucleotide gated (HCN) HCN channel.

Claims 1-12 and 36 as filed on December 20, 2010.

### ***Conclusion***

Claims 1-12 and 35-36 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JULIE HA whose telephone number is (571)272-5982. The examiner can normally be reached on Mon-Thurs, 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1654

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Julie Ha/  
Primary Examiner, Art Unit 1654